IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.:	09/488,337
Applicant(s):	Getsin et al.
Filed:	January 20, 2000
Title:	SYSTEM, METHOD AND ARTICLE OF MANUFACTURE FOR STORING SYNCHRONIZATION HISTORY OF THE EXECUTION OF A MULTIMEDIA EVENT ON A PLURALITY OF CLIENT COMPUTERS
Examiner:	Avellino, Joseph E.
Art Unit:	2143
Customer No.:	22242
Confirm. No.:	4283

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop: APPEAL BRIEF - PATENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit this appeal brief under 37 C.F.R. § 41.37 appealing the final rejection of Claims 1-24 in the Office Action mailed June 1, 2006.

(1) Real Party in Interest

The real party in interest in the subject application is Sonic Solutions.

(2) Related Appeals and Interferences

No related appeals or interferences are known to Appellant.

(3) Status of Claims

Claims 1-18 were submitted for examination in the application filed on January 20, 2000.

Claims 19-24 were added.

Claims 1, 6, 7, 12, 13 and 18 were amended.

Claims 1-24 remain pending.

Claims 1-24 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,769,130 in view of U.S. Patent No. 5,978,835 to Ludwig et al.

Claims 1-24 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,941,383 in view of Ludwig et al.

Claims 1-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,161,132 to Roberts et al. in view of Ludwig et al.

Claims 1-24 are appealed.

(4) Status of Amendments

No amendments have been filed subsequent to the final rejection mailed June 1, 2006.

(5) Summary of Claimed Subject Matter

The claimed embodiments are directed to methods, apparatuses and systems for use in synchronizing an even on a plurality of client apparatuses (Application, see at least page 20, lines 30-31). More specifically, claims 1 and 19 are directed to methods for storing synchronized information for subsequent playback of an event on a plurality

of client apparatuses. Claim 7 is directed to a computer program embodied on a

computer readable medium for storing synchronization information for subsequent

playback of an even ton a plurality of client apparatuses. Further, claim 13 is directed to

a system for storing synchronization information subsequent playback of an even on a

plurality of client apparatuses. Below is a concise explanation of at least the subject

matter defined in each of independent claim claims 1, 7, 13 and 19.

FIG. 3 from the application appears below for the convenience of the reader:

PROVIDING AN EVENT STORED IN MEMORY ON A PLURALITY OF CLIENT APPARATUSES, WHEREIN THE CLIENT APPARATUSES ARE ADAPTED TO BE CONNECTED TO A HOST COMPUTER VIA A NETWORK

300

STORING INFORMATION ON THE HOST COMPUTER FOR ALLOWING THE SIMULTANEOUS PLAYBACK OF THE EVENT ON EACH OF THE CLIENT APPARATUSES

302

ALLOWING THE INFORMATION TO BE DOWNLOADED UTILIZING THE NETWORK FOR PLAYBACK AFTER THE SIMULTANEOUS PLAYBACK
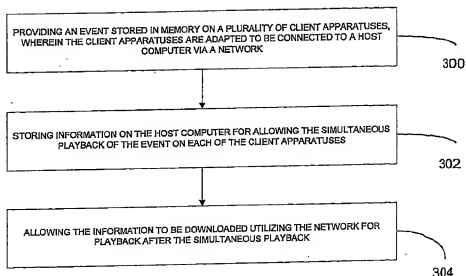
304

Figure 3

Some embodiments provide a plurality of client apparatuses (200, 300, 900, 1700) can

store an event in memory (114, 116, 120). This event can be stored on a portable storage

medium, downloaded and locally stored, or otherwise stored locally (App., see at least

page 20, line 30 - page 21, line 7; page 22, lines 20-24; page 24, lines 10-14; page 32,

lines 4-12). In some implementations, the event includes a multimedia presentation, such

as a video and audio presentation (114, 115, 120) (App., see for example, FIGS. 1, 17,

19; page 21, lines 2-22; page 22, lines 9-12). A host device, typically a computer, server

or the like, allows the client apparatuses to be cooperated to establish a simultaneous and synchronous playback of the events locally at the client apparatuses. (App., see at least FIGS. 1-10; page 10, lines 3-9; page 20, line 30 – page 22, line 16; page 22, line 26 – page 23, line 6; page 23, lines 10-20; page 24, lines 10-20; page 32, lines 14-23). The client apparatuses and a host computer can be connected to a network (135, 1800) allowing the host computer and the client apparatus (200, 400, 500, 600, 1700) to communicate (see at least App., FIGS. 1-6, 9, 11, 13-16, 17, 19; page 21, lines 24-25; page 23, lines 10-13; page 24, lines 10-14; page 32, lines 4-19).

In some instances, during and/or following the simultaneous playback, synchronization information can be stored for subsequent playback of an event on a client apparatuses (App., see at least FIGS. 1-6, 9, 11, 13-17 and 19; page 10, lines 17-32; page 20, line 30 - page 21, line 1-17; page 22, lines 20-24). During the event, the host computer can store information regarding the event, the simultaneous playback, timing information and/or other information (App. see at least FIGS. 1, 3, 7, 9, 10, 12-16, 17, 18; page 22, line 20 – page 23, line 6; page 29, lines 14-26, page 32, lines 14-19). For example, content and timing information transmitted during the simultaneous playback of the event are stored at the host computer (302, 304, 404, 804, 806, 1100, 1200, 1900) (App., see at least FIGS. 1, 3, 4, 8, 12-16, 19; page 22, line 26-32; page 23, lines 16 – page 24, lines 6; page 30, lines 25-32; page 34, lines 6-14 and 24-29; page 35, lines 13-27). This content and timing information can subsequently utilized (e.g., be downloaded utilizing the network) for playback of the event with the downloaded content and timing information after the simultaneous playback (304, 404, 506, 1900) (App., see at least FIGS. 1, 3, 5, 12-16, 19; page 22, line 20 – page 23, line 6; page 26, line 20 – page 27, line 29). In some instances, the timing information and/or history information at least in part provides some synchronization of the playback of the event and the downloaded content (App., see at least page 22, lines 9-32; page 23 lines 1-7).

The information stored on the host computer can include history and data (302) associated with the simultaneous playback (App., for example, FIGS. 1, 3; page 23,

lines 26-32), overlay material such as visual and/or audio material and/or other such information and/or data can similarly be recorded (see at least FIG. 4; App. page 23, lines 10-20). The network (135, 1800) can be or include substantially any relevant network, such as a wide area network, the Internet and/or other relevant networks (App., see at least page 18, lines 21-31; page 21, lines 24-27; page 36, lines 21-32). In some implementations, the event can be stored on a memory (114, 116, 120) that can include, for example, a digital video disc (DVD) (App., see at least page 10, line 23; page 21, lines 2-7), downloaded from over the network, and/or otherwise delivered to the client apparatuses.

      In various embodiments the memory (114, 116, 120) may take the form of an electromagnetic medium and/or other types of, medium including optical storage device (e.g., CD, DVD, etc.) or other relevant medium, for example the medium can include portable memory that can be received or purchased allowing users to participate in a synchronized event (App., see for example, page 20 line 30 – page 22, line 7). The information can include, in some instances, organization and/or chapter information associated (App., see at least page 20, line 30 – 21, line 7; page 22, lines 3-7; page 30, line 19 – page 31, line 32; page 43 lines 1-17). The present embodiments can further forward or download content to some users such that not all users have to store the event in memory, but rather can, for example, stream some or all of the event and/or content to one or more client apparatuses (App., see at least page 22, lines 9-16). The event can include video and/or audio presentation content, such as a movie, concert, and/or theatrical event. Further in some instances, the event may include substantially any recording capable of being played back for entertainment, education, informative or other similar purposes (App., for example, see page 22, line 19-22).

      In providing and/or establishing simultaneous playback, information can be transmitted from the host computer to the appropriate client apparatuses utilizing the network (135, 1800), that at least in part, allows for the simultaneous and synchronous playback of the event on each of the client apparatuses (App, page 21, lines 29-32).

History and other data associated with the synchronous playback can be recorded, for example at the host. The history may include overlaid material, specific commands affecting the playback of the information and/or other types of general information, e.g., start time, end time, and the like (App., see at least page 22, lines 26-32). After the synchronized event, the information can be downloaded and then used for playback of the event stored in memory after the simultaneous playback of the event (App., page 23, lines 1-6).

Regarding at least claim 7, some embodiments provide a computer program embodied on a computer readable medium (e.g., 114, 116, 120) that allows the storing of synchronization information that can be used in subsequent playback of an event on a plurality of client apparatuses (200, 300, 900, 1700) (App., see at least FIGS. 1-6, 9, 11, 13-17 and 19; page 10, lines 17-32; page 20, line 31 – page 21, line 17; page 22, lines 21-24). This event can be stored on a portable storage medium, downloaded and locally stored, or otherwise stored locally (App., see at least page 20, line 30 - page 21, line 7; page 22, lines 20-24; page 24, lines 10-14; page 32, lines 4-12). In some implementations, the event includes a multimedia presentation, such as a video and audio presentation (114, 115, 120) (App., see for example, FIGS. 1, 17, 19; page 21, lines 2-22; page 22, lines 9-12). The program allows the host device, typically a computer, server or the like, to cooperate with client apparatuses to establish a simultaneous and synchronous playback of the events locally at the client apparatuses. (App., see at least FIGS. 1-10; page 10, lines 3-9; page 20, line 30 – page 22, line 16; page 22, line 26 – page 23, line 6; page 23, lines 10-20; page 24, lines 10-20; page 32, lines 14-23). The client apparatuses and a host computer can be connected to a network (135, 1800) allowing the host computer and the client apparatus (200, 400, 500, 600, 1700) to communicate (see at least App. FIGS. 1-6, 9, 11, 13-17 and 19; page 10, lines 17-32; page 20, line 31 – page 21, line 25; page 22, lines 21-24; page 23, lines 10-14; page 24, lines 10-14; page 28, lines 11-14; page 32, lines 4-19).

In some instances, during and/or following the simultaneous playback, the program can cause content, timing and/or synchronization information of the event to be stored for subsequent playback of an event on a client apparatuses (302, 304, 404, 804, 806, 1100, 1200, 1900) (App., see at least FIGS. 1-6, 8, 9, 11, 13-17 and 19; page 10, lines 17-32; page 20, line 30 - page 21, line 17; page 22, lines 20-32; page 23, line 16 – page 24, line 6; page 30, lines 25-32; page 34, lines 6-14 and 24-29; page 35, lines 13-27). For example, during the event, the program can cause the host computer to store information regarding the event, the simultaneous playback, timing information and/or other information (App. see at least FIGS. 1, 3, 7, 9, 10, 12-16, 17, 18; page 22, line 20 – page 23, line 6; page 29, lines 14-26, page 32, lines 14-19). The content and timing information transmitted during the simultaneous playback of the event are stored, in some instances, at the host computer (302, 304, 404, 804, 806, 1100, 1200, 1900) (App., see at least FIGS. 1, 3, 4, 8, 12-16, 19; page 22, line 26-32; page 23, lines 16 – page 24, lines 6; page 30, lines 25-32; page 34, lines 6-14 and 24-29; page 35, lines 13-27). The program further includes code that allows the content and timing information to be subsequently utilized (e.g., be downloaded utilizing the network) for playback of the event with the downloaded content and timing information after the simultaneous playback (304, 404, 506, 1900) (App., see at least FIGS. 1, 3, 5, 12-16, 19; page 22, line 20 – page 23, line 6; page 26, line 20 – page 27, line 29). In some instances, the timing information and/or history information at least in part provides some synchronization of the playback of the event and the downloaded content (App., see at least page 22, lines 9-32; page 23 lines 1-7).

Further, claim 13 provides a system for storing synchronization information for subsequent playback of an event of a plurality of client apparatuses comprising one or more computer readable storage mediums (see at least page 21, lines 1-7). The readable computer storage mediums comprise logic that allows the storing of synchronization information that can be used in subsequent playback of an event on a plurality of client apparatuses (200, 300, 900, 1700) (App., see at least FIGS. 1-6, 9, 11, 13-17 and 19; page

10, lines 17-32; page 20, line 31 – page 21, line 17; page 22, lines 21-24). This event can be stored on a portable storage medium, downloaded and locally stored, or otherwise stored locally (App., see at least page 20, line 30 - page 21, line 7; page 22, lines 20-24; page 24, lines 10-14; page 32, lines 4-12). In some implementations, the event includes a multimedia presentation, such as a video and audio presentation (114, 115, 120) (App., see for example, FIGS. 1, 17, 19; page 21, lines 2-22; page 22, lines 9-12). Logic is further included that allows the host device, typically a computer, server or the like, to cooperate with client apparatuses to establish a simultaneous and synchronous playback of the events locally at the client apparatuses. (App., see at least FIGS. 1-10; page 10, lines 3-9; page 20, line 30 – page 22, line 16; page 22, line 26 – page 23, line 6; page 23, lines 10-20; page 24, lines 10-20; page 32, lines 14-23). The client apparatuses and a host computer can be connected to a network (135, 1800) allowing the host computer and the client apparatus (200, 400, 500, 600, 1700) to communicate (see at least App. FIGS. 1-6, 9, 11, 13-17 and 19; page 10, lines 17-32; page 20, line 31 – page 21, line 25; page 22, lines 21-24; page 23, lines 10-14; page 24, lines 10-14; page 28, lines 11-14; page 32, lines 4-19).

      In some instances, during and/or following the simultaneous playback, logic causes content, timing and/or synchronization information of the event to be stored for subsequent playback of an event on a client apparatuses (302, 304, 404, 804, 806, 1100, 1200, 1900) (App., see at least FIGS. 1-6, 8, 9, 11, 13-17 and 19; page 10, lines 17-32; page 20, line 30 - page 21, line 17; page 22, lines 20-32; page 23, line 16 – page 24, line 6; page 30, lines 25-32; page 34, lines 6-14 and 24-29; page 35, lines 13-27). For example, during the event, the logic causes the host computer to store information regarding the event, the simultaneous playback, timing information and/or other information (App. see at least FIGS. 1, 3, 7, 9, 10, 12-16, 17, 18; page 22, line 20 – page 23, line 6; page 29, lines 14-26, page 32, lines 14-19). The content and timing information transmitted during the simultaneous playback of the event are stored, in some instances, at the host computer (302, 304, 404, 804, 806, 1100, 1200, 1900) (App., see at

least FIGS. 1, 3, 4, 8, 12-16, 19; page 22, line 26-32; page 23, lines 16 – page 24, lines 6; page 30, lines 25-32; page 34, lines 6-14 and 24-29; page 35, lines 13-27). Logic is further included that allows the content and timing information to be subsequently utilized (e.g., be downloaded utilizing the network) for playback of the event with the downloaded content and timing information after the simultaneous playback (304, 404, 506, 1900) (App., see at least FIGS. 1, 3, 5, 12-16, 19; page 22, line 20 – page 23, line 6; page 26, line 20 – page 27, line 29). In some instances, the timing information and/or history information at least in part provides some synchronization of the playback of the event and the downloaded content (App., see at least page 22, lines 9-32; page 23 lines 1-7).

        With regard to claim 19, a method is provided for storing synchronization information for subsequent playback of an event on a plurality of client apparatuses. Some embodiments provide a plurality of client apparatuses (200, 300, 900, 1700) can store an event in memory (114, 116, 120). This event can be stored on a portable storage medium, downloaded and locally stored, or otherwise stored locally (App., see at least page 20, line 30 - page 21, line 7; page 22, lines 20-24; page 24, lines 10-14; page 32, lines 4-12). In some implementations, the event includes a multimedia presentation, such as a video and audio presentation (114, 115, 120) (App., see for example, FIGS. 1, 17, 19; page 21, lines 2-22; page 22, lines 9-12). A host device, typically a computer, server or the like, allows the client apparatuses to be cooperated to establish a simultaneous and synchronous playback of the events locally at the client apparatuses. (App., see at least FIGS. 1-10; page 10, lines 3-9; page 20, line 30 – page 22, line 16; page 22, line 26 – page 23, line 6; page 23, lines 10-20; page 24, lines 10-20; page 32, lines 14-23). The client apparatuses and a host computer can be connected to a network (135, 1800) allowing the host computer and the client apparatus (200, 400, 500, 600, 1700) to communicate (see at least App., FIGS. 1-6, 9, 11, 13-16, 17, 19; page 21, lines 24-25; page 23, lines 10-13; page 24, lines 10-14; page 32, lines 4-19).

In some instances, during and/or following the simultaneous playback, synchronization information can be stored for subsequent playback of an event on a client apparatuses (App., see at least FIGS. 1-6, 9, 11, 13-17 and 19; page 10, lines 17-32; page 20, line 30 - page 21, line 1-17; page 22, lines 20-24). During the event, the host computer can store information regarding the event, the simultaneous playback, timing information and/or other information (App. see at least FIGS. 1, 3, 7, 9, 10, 12-16, 17, 18; page 22, line 20 – page 23, line 6; page 29, lines 14-26, page 32, lines 14-19). For example, content and timing information transmitted during the simultaneous playback of the event are stored at the host computer (302, 304, 404, 804, 806, 1100, 1200, 1900) (App., see at least FIGS. 1, 3, 4, 8, 12-16, 19; page 22, line 26-32; page 23, lines 16 – page 24, lines 6; page 30, lines 25-32; page 34, lines 6-14 and 24-29; page 35, lines 13-27). This content and timing information can subsequently utilized (e.g., be downloaded utilizing the network) for playback of the event with the downloaded content and timing information after the simultaneous playback (304, 404, 506, 1900) (App., see at least FIGS. 1, 3, 5, 12-16, 19; page 22, line 20 – page 23, line 6; page 26, line 20 – page 27, line 29). In some instances, the timing information and/or history information at least in part provides some synchronization of the playback of the event and the downloaded content and can synchronize the playback of the event and the downloaded content (App., FIGS. 1, 3, 5, 12-16, 19; see at least page 22, lines 9-32; page 23 lines 1-7)

The information stored on the host computer can include history and data (302) associated with the simultaneous playback (App., for example, FIGS. 1, 3; page 23, lines 26-32), overlay material such as visual and/or audio material and/or other such information and/or data can similarly be recorded (FIG. 4; App. page 23, lines 10-20). The network (135, 1800) can be or include substantially any relevant network, such as a wide area network, the Internet and/or other relevant networks (App., see at least page 18, lines 21-31; page 21, lines 24-27; page 36, lines 21-32). In some implementations, the event can be stored on a memory (114, 116, 120) that can include, for example, a digital

video disc (DVD) (App., see at least page 10, line 23; page 21, lines 2-7), downloaded from over the network, and/or otherwise delivered to the client apparatuses.

(6) Grounds of Rejection to be Reviewed

The following issues are presented for review:

Issue 1: whether claims 1-24 are obvious in view of claims 1-13 of U.S. Patent No. 6,769,130 (referred to below as the '130 patent) to Getsin et al. in further view of U.S. Patent No. 5,978,835 to Ludwig et al (referred to below as the Ludwig patent).

Issue 2: whether claims 1-24 are obvious in view of claims 1-18 of U.S. Patent No. 6,941,383 (referred to below as the '383 patent) to Getsin et al. in further view of the Ludwig patent.

Issue 3: whether claims 1-24 are obvious in view of claims 1-48 of pending U.S. Patent Application Serial No. 10/880,272 (referred to below as the '272 application) to Getsin et al. in further view of the Ludwig patent.

Issue 4: whether claims 1-24 are obvious in view of U.S. Patent No. 6,161,132 to Roberts et al. (referred to below as the Roberts patent) in further view of the Ludwig patent.

Issue 5: whether the Examiner failed to fully consider Applicants' arguments.

(7) Argument

The following arguments are presented to contest the grounds for rejection presented above.

Issues 1-3: Claims 1-24 are not obvious in view of claims 1-13 of the '130 patent in view of the Ludwig patent, claims 1-18 of the '383 patent in view of the Ludwig patent, or claims 1-48 of the '272 application in view of the Ludwig patent.

Claim 1

Claim 1, recites in part "providing an event stored in memory on at least one of the client apparatuses … storing content and timing information transmitted during the simultaneous playback of the event at the host computer; and allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback." The office action indicates that the claims of the '130 and the '383 patents, and the '272 application do not disclose at least that "history information can be downloaded for playback [of the event] after the simultaneous playback," and instead relies on the Ludwig patent (June 1, 2006 office action, page 3). The Ludwig patent, however, does not describe allowing content and timing information to be downloaded for playback with an event stored in memory on a client apparatus, and further, the grounds for rejection ignored the fact that claim 1 provides that the content and timing information is downloaded "for playback of said event and said downloaded content and timing information" (claim 1).

The Ludwig patent fails to suggest allowing the downloading of content and timing information for playback with the event locally stored at the client apparatus. Further, the Ludwig patent specifically requires <u>all content</u> from <u>all parties</u> to be <u>recorded</u>, including recording the playback of any local content played during the conference call for later playback of the entire stored call. When someone attempts to later playback the recorded conference call, <u>all the recorded content</u> must be downloaded and played back. The Ludwig patent does not describe or suggest downloading content and timing information for playback with a locally stored event.

For example, at column 33, lines 45-50, the Ludwig patent in describing the recording of the conference call specifically recites:

> recording (storage) capabilities are preferably provided for
> <u>audio and video</u> of <u>all</u> parties, and also for <u>all</u> shared windows, including
> any telepointing and annotations provided during the teleconference.
> Using the multimedia synchronization facilities described above, these
> capabilities are provided in a way such that they can be replayed with
> accurate correspondence in time to the recorded audio and video, such as
> by synchronizing to frame numbers or time code events.
> (Ludwig, col. 33, lines 45-50, emphasis added).

The Ludwig patent requires that <u>all</u> content (i.e., all audio and video, shared windows,
telepointing and annotations) be recorded for later playback. Ludwig does not describe
or suggest at least the recording of content and timing and allowing the downloading of
content and timing information to be playback with locally stored event on the client
apparatus as recited in at least claim 1. Therefore, the applied combinations do not teach
all of the limitations of at least claim 1, and thus, Appellants respectfully request that the
double patenting rejections be withdrawn at least with respect to claim 1.

In the advisory action mailed August 24, 2006 in response to Applicants
response to the final office action of June 1, 2006, the Examiner states that "it is the
combination of '383 taken in view of Ludwig which renders the claimed limitation", the
Examiner continues stating that the "'383 provides the locally stored event" effectively
admitting that the Ludwig patent does not contemplate providing content and time
information to be played back with local content (advisory action, pg. 2). Further, the
Examiner in the advisory action states "Ludwig is able to capture a web collaboration
session (such as the one described in '383) and is able to reproduce this session at a later
time" (advisory action, page 2). Nowhere, however, has the Examiner demonstrated that
Ludwig teaches allowing the downloading of content and timing information for
playback with the locally stored content. Instead, the Examiner has validated Appellants
arguments. Specifically, Ludwig requires recording <u>the entire</u> web collaboration session
and only allows <u>the entire recorded session</u> to be later viewed. Therefore, the
combination at best provides recording an entire event including any local content played

back during the event, and allowing the recording of the entire chat session to be reviewed without accessing any locally stored event.

In the office action mailed June 6, 2006, the Examiner states that the claims of the '130 and '383 patents and the '272 application do not teach at least that "history information can be downloaded for playback after the simultaneous playback," and relies on Ludwig (office action, page 3). As described above, the Ludwig patent requires that <u>all</u> content (i.e., audio and video, shared windows, telepointing and annotations) be recorded for later review. Ludwig does not describe or suggest at least the recording of content and timing and allowing the downloading of content and timing information to be playback with locally stored event on the client apparatus as recited in claim 1. Therefore, the combination of the Ludwig patent with the claims of the '130 patent, the '383 patent or the '272 application fails to teach each limitation as recited in claim 1, and thus, a *prima facie* case of obviousness has not be established.

Claims 7, 13 and 19

With regard to at least claims 7, 13 and 19, as demonstrated above, the Ludwig patent fails to teach at least allowing the content and timing information to be downloaded utilizing the network for playback of a locally stored event and said downloaded content and timing information after the simultaneous playback. Claims 7, 13 and 19 recite language similar to that of claim 1 with respect to "allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback." The office action states that the claims of the '130 and '383 patents and '272 application fail to teach at least that "history information can be downloaded for playback after the simultaneous playback," and relies on Ludwig (office action, page 3).

However, as demonstrated above the Ludwig patent fails to teach at least allowing content and timing information to be downloaded utilizing the network for playback of locally stored event and said downloaded content and timing information

after the simultaneous playback as recited. The Ludwig patent requires that all content (i.e., audio and video, shared windows, telepointing and annotations) be recorded for later playback. Ludwig does not describe or suggest at least the recording of content and timing and allowing the downloading of content and timing information to be played back with locally stored event on the client apparatus as recited. As such, a *prima facie* case of obviousness has not been established.

Therefore, Appellants respectfully request that the double patenting and the provisional double patent rejections be withdrawn at least with respect to claims 7, 13 and 19.

Issue 4: Claims 1-24 are not obvious over the Roberts patent in view of the Ludwig patent.

Claim 1

Claim 1 as described above recites in part "providing an event stored in memory on at least one of the client apparatuses … and allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback." The Roberts patent does not teach, and the June 1, 2006 office action states that the Roberts patent does not disclose "storing content and timing information transmitted during the simultaneous playback … and allowing the content and timing information to be downloaded … for playback of said event and said downloaded content and timing information…" (office action, page 6). Instead, the office action relies on the Ludwig patent citing column 33, lines 45-50.

The Ludwig patent at column 33, lines 45-50, however, as demonstrated above requires that <u>all</u> content (i.e., audio and video, shared windows, telepointing and annotations) be recorded for later playback. The Ludwig patent does not describe or suggest at least the recording of content and timing and allowing the downloading of the recorded content and timing information for playback with the event locally stored at the

client apparatus. Instead, the Ludwig patent requires the recording of <u>all</u> content including real time audio and video from <u>all</u> parties along with <u>all</u> shared windows to allow for later playback. Specifically, the Ludwig patent states:

> recording (storage) capabilities are preferably provided for audio and video of <u>all</u> parties, and also for <u>all</u> shared windows (col. 33, lines 45-47, emphasis added).

Therefore, the Ludwig patent specifically requires that <u>all</u> content of a session be recorded and provided for later playback.

The Roberts patent also fails to teach or suggest, as admitted by the Examiner, the downloading of content and timing information for playback with the event on the client apparatus, and thus, the combination of the Roberts and Ludwig patents fails to teach each limitation as recited in at least claim 1. Further, even if one were to try and combine the Ludwig patent with the Roberts patent, the combination would not result in a system as recited by claim 1. Instead, at best the combination, if arguendo one skilled in the art would combine Roberts with Ludwig, would result in the recording of <u>all</u> the audio played back from a CD and <u>all</u> chat content of Roberts. The <u>entire recording</u> of the chat session (i.e., <u>all CD audio and chat content</u>) would be accessed for replay, and would not reference any locally stored content, as <u>all</u> content would be recorded and there would be no reason to reference local content. The Ludwig patent does not describe or suggest the playing back with locally stored content and instead teaches away from playing back with locally stored content because Ludwig requires the recording of <u>all</u> content. Therefore, the combination of the Roberts and Ludwig patents fails to describe every element of at least claim 1, and thus, claim 1 is not obvious over the applied combination.

Additionally, Appellants respectfully submit that one skilled in the art would not combine the Ludwig patent with the Roberts patent. MPEP section 2143 provides that:

> To establish a *prima facie* case of obviousness, ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings" (MPEP §2143). "If proposed modification would

> render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification (MPEP §2143.01).

Appellants submit that one skilled in the art would not combine the Ludwig patent with the Roberts patent in that the combination defeats the main objective of the Roberts patent in providing an <u>interactive experience</u> for the consumer "such that the consumer can also be a creator of the experience" (Roberts, col. 1, lines 63-65), since at best the combination would produce a prerecorded chat session where the consumer cannot participate in an interactive experience and cannot communicate nor interact with others. Specifically, the Roberts patent states that "[i]t is a further object of this invention to provide computer programs, systems, and protocols which allow such complementary entertainment to be <u>meaningfully interactive</u> for the consumer, such that the <u>consumer</u> can also be a <u>creator of the experience</u>" (Roberts, col. 1, lines 61-65, emphasis added). Therefore, it goes against the intended purpose of the Roberts patent to simply provide a recording playback as this fails to provide and instead prevents meaningful interactivity for a user and a user cannot be a creator of the experience. If a user is watching a recording of a session, the user is not actively participating and thus prevents a user from participating in a meaningful interactive experience. Thus, one skilled in the art would not combine the recording of Ludwig with the chat session of Roberts as this would go against the intended purpose of Roberts in providing an interactive session.

Further, the Roberts patent describes a chat session, relied on by the office action, that allows a user to interactively participate in the chat session where all of the users have some control over the playback of the audio recording during the chat session (see at least, col. 8, lines 3-4). As such, the Roberts patent teaches away from storing timing information and content, and playing back the content and timing information with the locally stored event since this would result in a recorded chat session where the users would not be able to interact and would have no control over the chat session, and would thus defeat the objective of the Roberts patent to "provide computer programs, systems, and protocols which allows such complementary entertainment to be

meaningfully interactive for the consumer, such that the consumer can also be a creator of the experience" (Roberts, col. 1, lines 61-65). Therefore, one skilled in the art would not combine the Roberts and Ludwig patents.

In the advisory action mailed August 24, 2006, the Examiner states that there is motivation to combine the teachings of Ludwig with Roberts since "the addition of Ludwig will allow the users of Roberts the ability to capture the session, and replay the session at a later time at their convenience" (Advisory Action, pg. 2). However, as described above, the combination defeats the main objective of the Roberts patent in providing entertainment that is "<u>meaningfully interactive</u> for the consumer, such that the consumer can also be <u>a creator</u> of the experience" (Roberts, col. 1, lines 63-65, emphasis added), since at best the combination would produce a prerecorded session where the consumer cannot participate in an interactive experience and cannot communicate nor interact with others. Therefore, the Examiner's grounds for combining supports Appellants' arguments in that the combination would at best produce a recorded session that can only be watched and defeats the intended purpose of the Roberts patent in providing an interactive session.

There is no motivation to combine the Ludwig patent with the Roberts patent as this would defeat the intended purpose of the Roberts patent, and thus, one skilled in the art would not combine the Ludwig patent with the Roberts patent. Therefore, a *prima facie* case of obviousness has not been established, and Appellants respectfully submit that at least claim 1 is patentable over the applied combination of the Roberts and Ludwig patents and that the rejections should be withdrawn.

Claims 7, 13 and 19

With regard to claims 7, 13 and 19 neither the Roberts patent nor the Ludwig patent teach at least allowing the content and timing information to be downloaded utilizing the network for playback of the locally stored event and said downloaded content and timing information after the simultaneous playback. Claims 7, 13 and 19

recite language similar to that of claim 1 with respect to "allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback." As shown above, with regard to claim 1, neither the Roberts patent nor the Ludwig patent teach at least allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback.

More specifically, the office action states that the Roberts patent does not disclose "storing content and timing information transmitted during the simultaneous playback … and allowing the content and timing information to be downloaded … for playback of said event and said downloaded content and timing information…" (office action, page 6). The office action instead relies on the Ludwig patent citing column 33, lines 45-50.

The Ludwig patent at column 33, lines 45-50, however, as demonstrated above requires that all content (i.e., audio and video, shared windows, telepointing and annotations) be recorded for later playback. Ludwig does not describe or suggest at least the recording of content and timing and allowing the downloading of the recorded content and timing information for playback with the locally stored event. Instead, Ludwig requires the recording of all real time audio and video from all parties along with all shared windows to allow for later playback.

Further, even if one were to try and combine Ludwig with Roberts, the combination would not result in a computer program, system or method as recited in claims 7, 13 and 19. More specifically, at best the combination, if arguendo one skilled in the art were to combine Roberts with Ludwig, would result in the recording of all the audio played back from a CD and all chat content of the Roberts patent. The entire recording of the chat session (i.e., all CD audio and chat content) would be accessed for replay, and would not reference any locally stored content, as all content would be recorded and there would be no reason to reference local content. The Ludwig patent

does not describe or suggest the playing back with locally stored content and instead
teaches away from playing back with locally stored content because the Ludwig patent
requires the recording of all content. Therefore, the combination of the Roberts and
Ludwig patents fails to describe every element of at least claims 7, 13 and 19, and thus, at
least claims 7, 13 and 19 are not obvious over the applied combination.

Additionally, as demonstrated above with regard to claim 1, Appellants
respectfully submit that one skilled in the art would not combine the Ludwig patent with
the Roberts patent. Such a combination would defeat the main objectives of the Roberts
patent in providing an interactive experience for the consumer "such that the consumer
can also be a creator of the experience" (Roberts, col. 1, lines 63-65), since at best the
combination would produce a prerecorded chat session where the consumer cannot
participate in an interactive experience and cannot communicate nor interact with others.
The Roberts patent describes the objectives as providing a chat session that allows a user
to interactively participate in the chat session where all of the users have some control
over the playback of the audio recording during the chat session (see at least, col. 8, lines
3-4). As such, the Roberts patent teaches away from storing timing information and
content, and playing back the content and timing information with the locally stored
event since this would result in a prerecorded chat session where the users would not be
able to interact and would have no control over the chat session, and would thus defeat
the main objective of the Roberts patent to "provide computer programs, systems, and
protocols which allows such complementary entertainment to be meaningfully interactive
for the consumer, such that the consumer can also be a creator of the experience"
(Roberts, col. 1, lines 61-65). Therefore, one skilled in the art would not combine the
Roberts and Ludwig patents.

Issue 5: The Examiner failed to fully respond to Appellants' arguments.

In "Amendment H," filed May 16, 2006, Appellants responded to the double
patenting rejection, in part, by traversing the rejections of all of claims 1-24. The office

action mailed June 1, 2006, failed to take note of the arguments with regard to claims 1-24, and failed to answer the substance of the arguments. As set forth at MPEP § 707.07(f), "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." The rejections of the office action mailed February 14, 2006 were maintained in June 1, 2006 final office action and the final office action failed to take note of and answer the substance of Appellants' arguments as actually presented in their response filed May 16, 2006. Therefore, Appellants submit that the pending office action errs in maintaining the rejections of the subject matter for claims 1-24 at least based on double patenting. Thus, Appellants respectfully request at least that the finality of the rejection be withdrawn.

(8) Claims Appendix

Provided is a complete listing of all the pending claims involved with this appeal:

Claim 1 (previously presented): A method for storing synchronization information for subsequent playback of an event on a plurality of client apparatuses, comprising the steps of:

providing an event stored in memory on at least one of the client apparatuses, wherein the client apparatuses and a host computer are adapted to be connected to a network;

storing information on the host computer for allowing a simultaneous playback of the same event from the memory on each of the client apparatuses;

storing content and timing information transmitted during the simultaneous playback of the event at the host computer; and

allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback.

Claim 2 (Original): A method as recited in claim 1, wherein the event includes a video and audio presentation.

Claim 3 (Original): A method as recited in claim 1, wherein the information includes a history and data associated with the simultaneous playback.

Claim 4 (Original): A method as recited in claim 1, wherein the network is a wide area network.

Claim 5 (Original): A method as recited in claim 1, wherein the memory includes a digital video disc (DVD).

Claim 6 (previously presented): A method as recited in claim 1, wherein the information includes chapter information associated with a DVD.

Claim 7 (previously presented): A computer program embodied on a computer readable medium for storing synchronization information for subsequent playback of an event on a plurality of client apparatuses, comprising:

a code segment for providing an event stored in memory on at least one of the client apparatuses, wherein the client apparatuses and a host computer are adapted to be connected to a network;

a code segment for storing information on the host computer for allowing a simultaneous playback of the same event from the memory on each of the client apparatuses;

a code segment for storing content and timing information transmitted during the simultaneous playback of the event at the host computer; and

a code segment for allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback.

Claim 8 (Original): A computer program as recited in claim 7, wherein the event includes a video and audio presentation.

Claim 9 (Original): A computer program as recited in claim 7, wherein the information includes a history and data associated with the simultaneous playback.

Claim 10 (Original): A computer program as recited in claim 7, wherein the network is a wide area network.

Claim 11 (Original): A computer program as recited in claim 7, wherein the memory includes a digital video disc (DVD).

Claim 12 (previously presented): A computer program as recited in claim 7, wherein the information includes chapter information associated with a DVD.

Claim 13 (previously presented): A system for storing synchronization information for subsequent playback of an event on a plurality of client apparatuses, comprising:

one or more computer readable storage mediums comprising:

logic for providing an event stored in memory on at least one of the client apparatuses, wherein the client apparatuses and a host computer are adapted to be connected to a network;

logic for storing information on the host computer for allowing a simultaneous playback of the same event from the memory on each of the client apparatuses;

logic for storing content and timing information transmitted during the simultaneous playback of the event at the host computer; and

logic for allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback.

Claim 14 (Original): A system as recited in claim 13, wherein the event includes a video and audio presentation.

Claim 15 (Original): A system as recited in claim 13, wherein the information includes a history and data associated with the simultaneous playback.

Claim 16 (Original): A system as recited in claim 13, wherein the network is a wide area network.

Claim 17 (Original): A system as recited in claim 13, wherein the memory includes a digital video disc (DVD).

Claim 18 (previously presented): A system as recited in claim 13, wherein the information includes chapter information associated with a DVD.

Claim 19 (previously presented): A method for storing synchronization information for subsequent playback of an event on a plurality of client apparatuses, comprising the steps of:

providing an event stored in memory on at least one of the client apparatuses, wherein the client apparatuses and a host computer are adapted to be connected to a network;

storing information on the host computer for allowing a simultaneous playback of the same event from the memory on each of the client apparatuses;

storing content and timing information transmitted during the simultaneous playback of the event at the host computer; and

allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback;

wherein the timing information synchronizes the playback of said event and the downloaded content.

Claim 20 (previously presented): A method as recited in claim 19, wherein the event includes a video and audio presentation.

Claim 21 (previously presented): A method as recited in claim 19, wherein the information includes a history and data associated with the simultaneous playback.

Claim 22 (previously presented): A method as recited in claim 19, wherein the network is a wide area network.

Claim 23 (previously presented): A method as recited in claim 19, wherein the memory includes a digital video disc (DVD).

Claim 24 (previously presented): A method as recited in claim 19, wherein the information includes chapter information associated with a DVD.

(9) Evidence Appendix

None

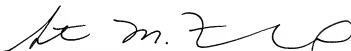## (10) Related Proceedings Appendix

None

CONCLUSION

Appellants submit that the rejections of the pending claims 1-24 are in err, and that claims 1-24 are not obvious in view of the cited reference.

Appellants respectfully request a reversal of the final rejection.

Dated: _11-29-06_

Respectfully submitted,

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